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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,665	06/28/2001	Carlos F. Barbas	TSRI 645.1	2213

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EXAMINER

CARLSON, KAREN C

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/807,665

Applicant(s)

BARBAS, CARLOS F.

Examiner

Karen Cochrane Carlson, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 13, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 22-37 is/are pending in the application.
- 4a) Of the above claim(s) 22-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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This Office Action is in response to the amendment filed on December 13, 2004. Claims 2-21 have been canceled. Claims 1 and 22-37 are currently pending.

Applicant's election with traverse of Invention 41, SEQ ID NO: 41 in the paper filed March 8, 2004 was acknowledged and searched in the first action on the merits (ie, the previous Office Action). The traversal was on the ground(s) that Applicants urged that the sequences listed in previously amended Claim 1 are unified by the structure RSDXLV(R/K). It was noted that the amino acid sequence of elected SEQ ID NO: 41 is KSADLKR and does not share this structural sequence. Therefore, the argument that there is a single structure to be searched for all of the sequences listed in previously amended Claim 1 was not considered to be persuasive. The polynucleotide encoding SEQ ID NO: 41 was rejoined because search of the polypeptide resulted in art for the encoding polynucleotide and therefore did not pose an undue burden on the Examiner.

New Claims 22-37 are drawn to zinc finger proteins comprising 2-12 *different* nucleotide binding regions selected from SEQ ID NOs: 1-110. Only SEQ ID NO: 41 was searched in the previous Office Action. Therefore, new Claims 22-37 are withdrawn from further consideration because these claims are drawn to non-elected inventions. Thus, only Claim 1 is currently under examination.

The Office does not have the resources to search 110 unrelated sequences. It would take days just to accomplish an electronic sequence search of the databases. It would take days for the Examiner to review the sequence searches and correlate art for such a claim. Thus, it would take well over a week of uninterrupted time to arrive at a first action on the merits. It would have been helpful to Applicants and the Examiner if a few consensus sequences had been provided, each representing specific sequences, to ease the search burden. However, in those circumstances, it would be understood that the consensus sequence represents all sequences designated by Applicants and if the consensus sequence were found then all

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sequences represented thereby would be considered to be obvious variants of each other and rejected accordingly.

The IDS filed April 77, 2002 did not have a PTO-1449 attached, or references attached.

Applicants argue that a PTO 1449 was attached to this IDS. As noted, it is not in the file.

Please replace the PTO 1449.

Priority is set to **October 16, 1998**. The Examiner apologizes for the error in the year for priority as stated in the previous Office Action.

Withdrawal of Rejections

The rejection of Claims 1-19 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-56 of U.S. Patent No. 6,242,568 is withdrawn.

The rejection of Claims 1-13 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-39, 53 of U.S. Patent No. 6,140,466 is withdrawn.

The rejection of Claims 20 and 21 under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, is withdrawn.

The rejection of Claims 1-21 under 35 U.S.C. 112, second paragraph, is withdrawn.

The rejection of Claims 2-7 and 14-22 under 35 U.S.C. 103(a) as being unpatentable over Barbas et al. (USP 6,242,568, issued June 5, 2001 and having a 102(e) date of December 30, 1996), is withdrawn.

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Maintenance of Rejections

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 1 is again rejected under 35 U.S.C. 102(e) as being anticipated by Barbas et al.

(USP 6,242,568, issued June 5, 2001 and having a 102(e) date of December 30, 1996).

Barbas et al. teach C7 zinc finger nucleotide binding polypeptide containing instant SEQ ID NO: 41 (KSADLKR) in Figure 15 and in patent SEQ ID NO: 42 at amino acids 20-26 (Claim 1).

USP 6,140,466 (priority to at least May 27, 1997) is the same up through Example 13 of USP 6,242,568 and would be applied in the same manner as 6,242,568.

At page 8 of their response, Applicants argue that '568 does not teach or suggested an isolated polypeptide that consists essentially of SEQ ID NO: 41. It is not clear why Applicants state this when there are at least 3 regions comprising SEQ ID NO: 41 in the amino acid sequence shown in Figure 15 alone. The phrase "consisting essentially of" is open language, and therefore this rejection stands.

No Claims are allowed.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER